

REMARKS**A. Claim Objections - 35 U.S.C. § 112**

In accordance with the Examiner's requests, Applicant has amended claims 33-35 to address the antecedent basis informalities identified. Applicant believes that the changes correct these claims. Withdrawal of the rejection is respectfully requested.

B. Claim Rejections - 35 U.S.C. § 103

Claims 1 through 36 stand rejected by the Examiner pursuant to 35 U.S.C. § 103 over DeMarcken et al. (U.S. Patent no. 6,377,932) in view of Acebo et al. (U.S. Patent No. 6,923,679) and Son (New York Daily News). Applicant requests reconsideration of the application in light of the remarks and amendments contained herein.

Applicant respectfully submits that the Examiner has not set forth a *prima facie* case of obviousness for the independent claims. In this regard, the Examiner bears the initial burden of demonstrating a *prima facie* case of obviousness. *In re Rinehart*, 531 F.2d 1048, 189 U.S.P.Q. 143 (C.C.P.A. 1976). A *prima facie* case requires, *inter alia*, a showing of all of the elements of the claims in the prior art and some suggestion or motivation to modify or combine the references based upon the prior art or a general knowledge in the field, *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998); See MPEP § 2143. The simple fact that a reference is capable of being modified to perform a claimed feature is insufficient as a basis for a nonobvious rejection without some suggestion to do so. *In re Mills*, 916 F.2d 680, 682, 16 USPQ.2d 1430 (Fed. Cir. 1990).

In the present rejection, for the following reasons, *inter alia*, all of the elements of the pending claims as recited in

In the Drawings

In accordance with the Examiner's request, the typographical and copying errors in Figure 11 have been corrected. Thus, the spelling of the word "request" has been corrected and the fold mark has been removed. Formal drawings with the corrections are being submitted herewith.

independent claims 1, 9, 12, 17 and amended claim 29¹ are not shown or suggested by the prior art relied upon by the Examiner.

With regard to claim 1, while the Examiner reads *DeMarcken* for much of the disclosure of claim 1, the Examiner at least acknowledges that *DeMarcken* does not teach the claimed compilation including at least two distinct product types or that the defined restrictions for at least one product in a package depend on at least another product accepted in or excluded from the package. The Examiner also correctly concludes that *Acebo et al* does not disclose computerized compilation systems packaging products by defined restrictions with at least one product in a package [being] dependent on another product accepted in or excluded from the package. For this later element, the Examiner attempts to rely on *Son*. Nevertheless, the obviousness rejection is incomplete.

There appears to be a significant misunderstanding of the Applicant's invention. Claim 1 defines a "computer-based e-commerce system dynamically formulating a collection of multiple vendor offered products" an element of which expressly includes a "computerized intelligent compilation of packages ... each package including at least two distinct products of two product types that are matched based on a congruency matching of defined restrictions ... wherein the defined restrictions for at least one product in a package are dependent on another product accepted in or excluded from the package". These elements are not disclosed by any of the references relied upon by the Examiner. Neither *DeMarken*, *Acebo et al.* nor *Son* teach the dynamic computerized compilation package having the defined restrictions either alone or in combination.

To this end, the computerized systems relied upon by the Examiner are *DeMarken* and *Acebo et al.* and it is acknowledged

¹Claim 29 has been amended herein to more clearly recite the

that they do not supply the complete invention. Indeed the absence of any disclosure of the missing element in the two patented systems is an indication of the non-obviousness of the acknowledged missing element.

Son, a newspaper article, does not teach the claim elements that are missing from *DeMarken* and *Acebo*. In a seemingly hindsight effort to complete the rejection it seems that the Examiner is not giving full consideration to the extent of the dynamic computerized nature of the compilation by the defined product dependent accepted or excluded restrictions as claimed. In this regard, *Son* does not disclose a system having computerized compilation by the defined restrictions and as such it will not complete the obviousness rejection. At best, *Son* only discloses an advertised travel package offered by a travel agent. There is no disclosure detailing how such packages are created or by what system, yet alone in the fashion required in the claims. The reference clearly does not disclose or suggest a computerized dynamic compilation package of the system invention claimed. To the contrary, the very static nature of the news paper article advertisement suggests something other than the dynamic computerized compilation packaging system of Applicant's invention. In this regard, the reference not only does not fully teach the invention in combination with the relied on references, it actually teaches away from the applicant's invention, thus rendering its combination with either *DeMarken* and *Acebo et al.* inappropriate.

Moreover, we respectfully submit that the proffered suggestion for combining the reference is legally deficient. Ignoring for the moment that *Son* teaches away from the invention and it does not complete the disclosure of all the elements of the invention, a suggestion to combine must be sufficient to

invention claimed.

motivate one skilled in the art to do what the Applicant did. The Examiner contends that the article teaches packaging by certain restrictions "for the benefit of increasing customer loyalty." While the Examiner does not point to any language of the advertisement that actually expresses this teaching, we submit that such a veiled suggestion is nothing more than a broad and conclusory statement that is not sufficient to evidence a prior art motivation or suggestion to modify the computerized systems of *DeMarken* and *Acebo et al.* to create the claimed invention. See *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000). It would require a substantial evidentiary demonstration not present in the current office action to extrapolate this unwritten desire for customer loyalty into creating the claimed dynamic computerized packaging with the restrictions for at least one product in the package being dependent on another product accepted in or excluded from the package. In this light, the rejection is more akin to an improper hindsight reconstruction that follows only the teachings disclosed in the Applicant's specification.

For these reasons, the rejection falls short of the showing required for a *prima facie* claim of obviousness. Therefore, withdrawal of the rejection of claim 1 and its dependent claims is respectfully requested since the claimed invention is both novel and non-obvious.

Similarly, the inventions defined in the remaining independent claims with respect to the missing elements discussed above are comparable to claim 1. In this regard, claim 9 also defines dynamic computerized intelligent compilation of travel packages by the defined restrictions that include a product dependent on another product accepted in or excluded from the package. Similarly, claim 12 defines a computer-based e-commerce method for dynamically formulating a collection of vendor offered travel products intelligently

compiling packages by the defined product accepted or excluded restrictions. Claim 17 defines the computer-based e-commerce system dynamically formulating collections of travel products with an intelligent matching mechanism retained within the centralized travel packaging system having criteria with the defined product accepted or excluded restrictions. Claim 29 similarly defines a computer based e-commerce method performed by at least one processor having a centralized packaging system with an intelligent matching and dynamic compilation mechanism determining travel packages with the product accepted or rejected packaging restrictions. For these reasons, Applicant requests that these claims be allowed along with claim 1 since a *prima facie* claim of obviousness has not been made.

While Applicant additionally disagrees with the Examiner's reading and reliance on the disclosure of *DeMarken* and *Acebo et al.* for additional reasons, the absence of a *prima facie* case as discussed herein renders a more detailed discussion of the reasons unnecessary at this time.

Finally, Applicant has amended claim 12 for purposes of correcting a typographical omission of claimed terms therein. The words "two" and "travel" have been added to coordinate the amended terms with their antecedent basis.


Accordingly, the pending claims recite subject matter neither taught nor suggested by the relied on references. Thus, it is believed that all of the rejections set forth in the Official Action have been fully met, favorable reconsideration and allowance are earnestly solicited.

If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he/she telephone applicant's attorney at (908) 654-5000 in order to overcome any additional objections which he might have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

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Respectfully submitted,

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